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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,794	09/19/2000	Franklin C. Bradshaw	PM 271077	1859

909 7590 09/19/2002

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EXAMINER

SELLS, JAMES D

ART UNIT

PAPER NUMBER

1734

DATE MAILED: 09/19/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/664,794

Applicant(s)

BRADSHAW ET AL.

Examiner

James Sells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 36-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

**DETAILED ACTION**

***Reissue Applications***

1. Applicant's new Reissue Declaration filed June 17, 2002 is acceptable and the rejection of claims 36-48 as being based on a defective reissue declaration under 35 U.S.C. 251 is hereby withdrawn by the examiner.
2. Applicant's new Assignee Consent filed June 17, 2002 is noted and the certification under 37 C.F.R. 3.73(b) is acceptable.
3. Applicant's paper filed June 17, 2002 providing an explanation of support for the presently pending claims is acceptable and the amendments filed December 20, 2000 and May 16, 2001 comply with 37 CFR 1.173(c).
4. As stated in the last office action, Claims 36-46 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the

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application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In US Patent Application 08/247,003 (US Patent 5,584,962), applicant surrendered subject matter during prosecution of the application in order to overcome a rejection. This surrendered subject matter includes: a pretensioning means including a tensioning cap affixed to the cores the caps having an end plate engaging the end of the associated core and the plate with securement means engagable in the mounting means and further including biasing means for applying a predetermined force biasing the end plate into engagement with the end of the roll core. Newly added claim 36 does not include the limitations which applicant presented in application 08/247,003 to overcome the prior art of record. Thus applicant is attempting to recapture subject matter that was surrendered in application 08/247,003. See MPEP 1412.02 – examples A-C.

### ***Response to Arguments***

Applicant's arguments filed June 17, 2002 have been fully considered but they are not persuasive.

Applicant acknowledges that the above limitations were added to claim 10 of the '962 patent for purposed of securing its allowance. However, applicant asserts that the limitations in claims 36 and 47 concerning the "outer shell portion" materially narrow the reissue claims in that they define the specific parts of the frame that move relative to

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one another. Thus, applicant concludes that claims 36 and 47 are materially different than patent claim 10 and allowing applicant to broaden out the claim limitations concerning the "pre-tensioning means" would not constitute impermissible recapture because the applicant is not regaining the same claim scope sought during prosecution of the patent.

The examiner does not agree with applicant's conclusion. The narrowing aspect of the claims (i.e. the newly added "outer shell portion") is not related to the broadening aspect (i.e. the "pre-tensioning means"). Therefore, the reissue claims have not been narrowed in any material respect compared with their broadening. Thus the newly added narrowing limitation does not modify the claims such that the scope of the claims no longer result in a recapture of the surrendered subject matter. Furthermore, "if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution, this flexibility of analysis is eliminated, for the prosecution history establishes the substantiality of the change and estops its recapture." *Anderson v. Int'l Eng'g & Mfg., Inc.*, 160 F.3d 1345, 1349, 48 USPQ2d 1631, 1634 (Fed. Cir. 1998); see also *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525 ("[I]n this case, the reissue claims are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution. Mentor thus attempted to reclaim what it earlier gave up.") Also see *Pannu v. Storz Instruments Inc.*, 59 USPQ2d 1597 (CAFC 2001).

Applicant argues that the proper focus is on the scope of the claims, not on the individual feature or element purportedly given up during prosecution of the original application. Applicant further asserts that the examiner has simply identified the

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imitations from claim 10 that are no longer present in the pending independent reissue claims, and has not focused on the other, materially narrowing changes made to the claim scope. The examiner does not agree. The examiner has considered the materially narrowing changes relating to the "outer shell portion." However, these narrowing limitations do not affect and are not related to the limitations concerning the "pre-tensioning means". Thus the newly added limitations relating to the "outer shell portion" do not affect the scope of the limitations concerning the "pre-tensioning means" and the applicant's argument is believed to be incorrect in this instance.

#### ***Telephone/Fax***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sells whose telephone number is (703) 308-2090. The examiner can normally be reached on Monday-Friday between 9:30 AM and 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

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***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



**JAMES SELLS  
PRIMARY EXAMINER  
TECH. CENTER 1700**